

### **REMARKS/ARGUMENTS**

At the time of the Office Action dated January 15, 2009 (hereinafter, "Office Action"), claims 1-63 were pending in the present application. In the Office Action, claims 1-27 and 31-60 were allowed. Claims 28-30 and 61-63 were rejected. Applicant respectfully responds to the Office Action.

**I. Claims 28-30 and 61-63 were rejected under 35 U.S.C. § 101**

Claims 28-30 and 61-63 were rejected under 35 U.S.C. §101 because they are directed to "software" per se.

It is not clear where the Office Action finds any support for the statement "While these means plus functions may be directed to the software implementation of the disclosure (paragraphs 00131 – 132) which is non-statutory since the apparatus with this implementation contains only software."

Furthermore, claims may cover both hardware and software embodiments. For instance, in *Overhead Door Corp. v. Chamberlain Group, Inc.*, 194 F.3d 1261, 1271-73 (Fed.Cir. 1999), the court held that one skilled in the art would have understood that a patent's disclosure of a flow diagram represented disclosure of an alternative software embodiment of a switch. The court concluded that the district court should have included software as corresponding structure to the switch means limitation in the patent. *See Id.* at 1273, "The differences in claim language, bolstered by the patentees' statements during the reissue proceedings, cause this court to reach a broader construction for claim 5 than for claim 1. . . . The district court erred in ruling that only the mechanical switch in Figure 2 is 'corresponding structure' for the claimed 'switch means.' 'Switch means,' when properly construed, also covers the software-based embodiment described in Figure 3."

*Overhead Door Corp.* was followed by the court in *DE Techs, Inc. v. Dell, Inc.*, 428 F.Supp2d 512, 518 (W.D. Va. 2006), which stated "In that case [*Overhead Door Corp.*], the issue was whether the corresponding structure 'memory selection second switch means' encompassed a software-based embodiment. *Overhead Door Corp.* at 1272. After discussing its analysis of Figure 3, that would be understood to include software operations, the Court found

that statements made during the prosecution of the patent "further support a broader construction" of the term." Since claims 28-30 and 61-63 may cover both hardware and software embodiments, these claims are drawn to patent eligible subject matter under 35 U.S.C. § 101 and are valid.

***Allowable Subject Matter***

Applicant notes with appreciation the allowance of claims 1-27 and 31-60.

**CONCLUSION**

In view of the foregoing, Applicant respectfully submits that all pending claims in the present application are in a condition for allowance, which is earnestly solicited. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Applicants further would like to direct the Examiner's attention to co-pending Continuation Application No. 11/330,734.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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